

Notice of Allowability

Application No.

10/581,164

Examiner

Binta M. Robinson

Applicant(s)

BENESH ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the IDS filed 5/31/06.
2. ☒ The allowed claim(s) is/are claims 13, 14, 15 (now renumbered as claims 1-3).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 5/31/2006
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

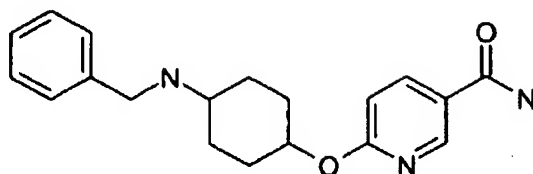
Authorization for this examiner's amendment was given in a telephone interview with Attorney Demeter on 2/1/07.

The application has been amended as follows:

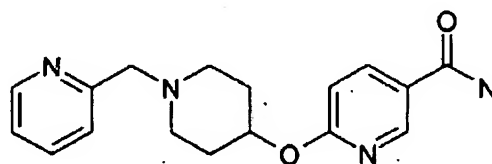
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A. In claim 13, page 3,

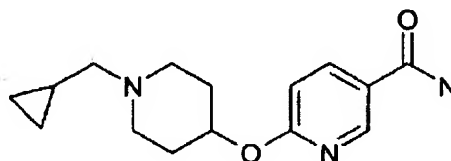
"



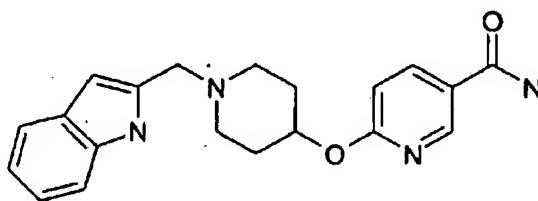
6-(1-Pyridin-2-ylmethyl-piperidin-4-yloxy)-nicotinamide



6-(1-Cyclopropylmethyl-piperidin-4-yloxy)-nicotinamide



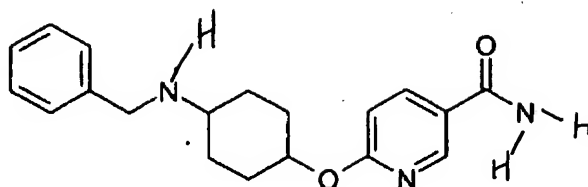
6-[1-(1H-Indol-2-ylmethyl)-piperidin-4-yloxy]-nicotinamide



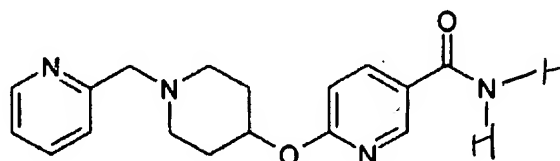
"

" is amended to –

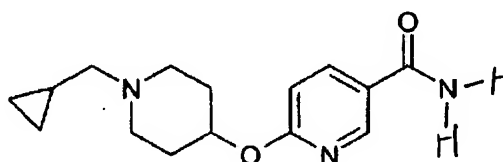
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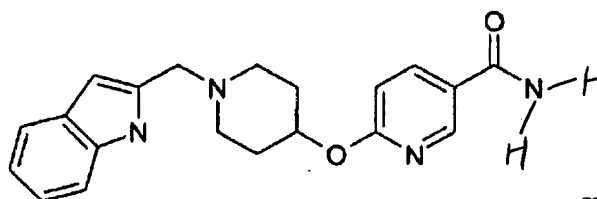
6-(1-Phenylmethyl-piperidin-4-yloxy)-nicotinamide



6-(1-Cyclopropylmethyl-piperidin-4-yloxy)-nicotinamide

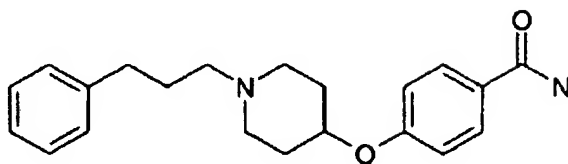


6-[1-(1H-Indol-2-ylmethyl)-piperidin-4-yloxy]-nicotinamide



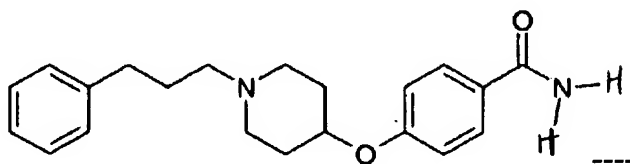
B. In claim 13, line 6, page 3,

4-[1-(3-Phenyl-propyl)-piperidin-4-yloxy]-benzamide



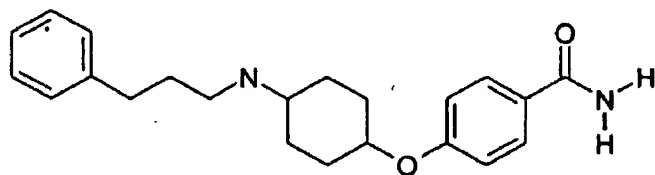
" is amended to --

4-[1-(3-Phenyl-propyl)-piperidin-4-yloxy]-benzamide

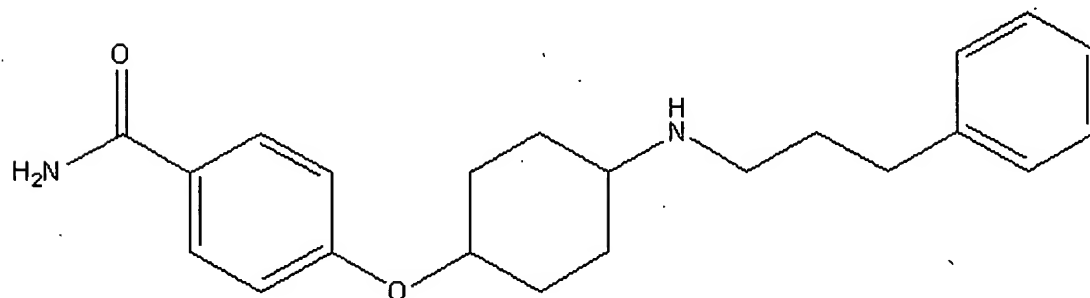


C. In claim 13, line 9, page 2, the compound

4-[4-(3-Phenyl-propylamino)-cyclohexyloxy]-benzamide



" is amended to ---

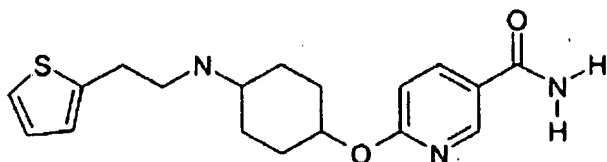


4-[4-(3-phenyl-propylamino)-cyclohexyloxy]-benzamide

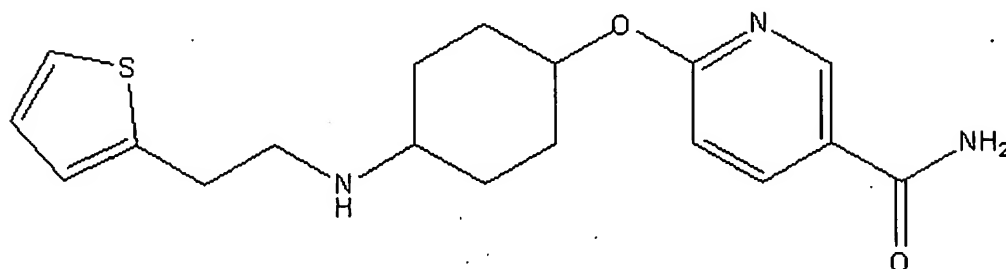
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D. In claim 13, line 7, page 2, the compound

6-[4-(2-Thiophen-2-yl-ethylamino)-cyclohexyloxy]-nicotinamide



" is amended to--



6-[4-(2-thiophen-2-yl-ethylamino)-cyclohexyloxy]-nicotinamide

E. Claims 17 and 19 are cancelled without prejudice to the applicant filing a divisional application on these claims.

F. In claim 13, lines 1-2, page 4, the phrase " , solvate, enantiomer, diastereomer or a diastomeric mixture thereof" is deleted.

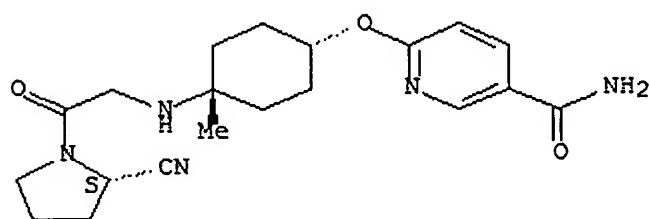
Examiner's Comments

The support for the changes to the compounds is in the fact that the nomenclature indicates that acyclic nitrogens in the compounds are only substituted with hydrogens and that these hydrogens were inadvertently excluded from the compounds.

Reasons For Allowance

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The closest prior art reference is Hcaplus 136:325560. (See Reference U). One of the primary differences between the Hcaplus 136:325560 compound and the instantly claimed compound is the substitution at the 4 position of the cyclohexyl ring. In the instant compound, there is only a 2-thiophen-2-yl-ethylamino- substituted at the 4 position. In the Hcaplus 136:325560 compound, there is a methyl group as well as a 2-cyano-1-pyrrolidinyl group substituted at the 4 position of the ring. See the compound



● HCl

The prior art reference does not teach nor suggest to one of ordinary skill in the art how to modify the prior art compound to derive the instant compound.

Therefore the claims are allowable therefrom.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Thomas McKenzie can be reached on 571-272-0670. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

BMR
February 1, 2007

A handwritten signature in black ink, appearing to read "B Dentz", is positioned above the printed name.

BERNARD DENTZ
PRIMARY EXAMINER